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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/570,485

03/03/2006

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EXAMINER

MI, QIUWEN

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/570,485	<b>Applicant(s)</b> KATO ET AL.	
	<b>Examiner</b> QIUWEN MI	<b>Art Unit</b> 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 and 7-15 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/3/06 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/3/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Election/Restrictions**

Claims 1-15 are pending.

Applicant's election of Group I, claims 1-5, and 7-15 in the reply filed on 9/15/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 6 is withdrawn from further consideration as being drawn to nonelected inventions.

**Claims 1-5, and 7-15 are examined on the merits.**

### **Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 5, 7, and 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites parenthetical expression "(hereinafter called the “Gnetum seed extractable material)”. The metes and bounds of Claim 1 are rendered vague and indefinite by the

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parenthetical recitation of “(hereinafter called the “Gnetum seed extractable material)” because it is unclear as to whether the limitation is part of the instantly claimed subject matter.

There is insufficient antecedent basis for the limitations in the following claim.

Claim 4, line 1, "the sold content";

Claim 10, line 3, “the absorption maximum”;

Claim 10, line 4, “the spot”;

Claim 13, line 3, “the absorption maximum”;

Claim 13, line 4, “the spot”.

Claims 7, 11, and 14 recite “reformed vegetable extract”, and it is uncertain what it means by “reformed”. The specification does not have any description or definition about “reformed vegetable extract. Therefore, the metes and bounds of claims are rendered vague and indefinite. The lack of clarity renders the claims very confusing and ambiguous since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

### **Claim Rejections –35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 9 are rejected under 35 USC § 102 (b) as being anticipated by Boralle et al (Oligostibenoids from *Gnetum venosum*, *Phytochemistry*, 34 (5): 1403-1407, 1993).

Boralle et al teach extracting the seeds of *Gnetum venosum* by exhaustive percolation with EtOH (thus a solid-liquid mixture, an organic solvent, a polar organic solvent). The solution was evaporated (thus solid content is removed) and the residue partitioned between CHCl<sub>3</sub>, and MeOH. The solvents were evaporated. The residue of the CHCl<sub>3</sub> solution was fractionated first by CC and finally by TLC. All compounds were purified by HPLC (see title; page 1407, 1st column, 5th paragraph).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as cosmetic or seasoning products. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Claims 1, and 9 are rejected under 35 USC § 102 (b) as being anticipated by Conte (Storage globulins in *Gnetopsida*. 1. Recognition of legumin-like proteins. *Giornale Botanico Italiano*, (1994) Vol. 128, No. 5, pp 839-843).

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Conte teaches that seeds of *Ephedra distachya*, *Ephedra foeminea*, *Gnetum gnemon*, *Gnetum montanum* and *Welwitschia mirabilis* were homogenized in tris-glycine-buffer (page 840, 3<sup>rd</sup> paragraph) (thus a water extract, a solid-liquid mixture, a reformed vegetable extract), and separated by chromatographic procedures (see Abstract).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as cosmetic or seasoning products. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

### **Claim Rejections –35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boralle et al (Oligostibenoids from *Gnetum venosum*, *Phytochemistry*, 34 (5): 1403-1407, 1993), in view of Berry (Cyclopropene fatty acids in *Gnetum gnemon* (L.) seeds and leaves, *Journal of the Science of Food and Agriculture*, (1980) Vol. 31, No. 7, pp. 657-662).

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Boralle et al teach extracting the seeds of *Gnetum venosum* by exhaustive percolation with EtOH (thus a solid-liquid mixture, an organic solvent, a polar organic solvent). The solution was evaporated (thus solid content is removed) and the residue partitioned between  $\text{CHCl}_3$ , and MeOH. The solvents were evaporated. The residue of the  $\text{CHCl}_3$  solution was fractionated first by CC and finally by TLC. All compounds were purified by HPLC (see title; page 1407, 1st column, 5th paragraph).

Since the reference teaches extracting the claimed material *Gnetum* seeds with the claimed solvent ethanol, it is deemed that the extracts would intrinsically have the claimed absorption spectrum and Rf value.

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that the prior art product must not be precluded for use as cosmetic or seasoning products. It is deemed that the composition disclosed by the cited reference is not precluded for carrying out the intended function of the claims.

Boralle et al do not explicitly teach using 50% EtOH to extract *Gnetum* seeds, nor do Boralle et al teach mixing *Gnetum* extract to vegetable extract.

Berry teaches seed kernels of *Gnetum gnemon*, eaten after boiling or roasting the nuts (see Abstract). Berry teaches that nuts are starchy, astringent and rather bitter in taste that persists even after cooking. The kernels are eaten after removing the shell from the roasted or boiled nuts. They are mashed, moulded into cakes, biscuits or pounded flat into 'keropok' (crisps) which are dried in the sun and deep-fried in oil prior to consumption (page 44, 1st

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paragraph). Berry also teaches the young leaves of the plant are consumed as vegetable (page 44, 2<sup>nd</sup> paragraph).

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to adjust the concentration of EtOH to extract the Gnetum seeds from Boralle et al according to the polarity of the constituent in the seeds that is desired to isolate, as the result-effective adjustment in conventional working parameters (e.g., determining an appropriate concentration of the solvent) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to boil the Gnetum gnemon kernels (the same as seeds) and leaves (thus mixing with vegetable extract) together (thus a polar extract) and then to consume since Berry teaches both the kernel and leaves can be eaten.

Since both of the references teach Gnetum seed, one of ordinary skill in the art would have been motivated to make the modifications and combine the references together.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

## Conclusion



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No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QM

/Michele Flood/

Primary Examiner, Art Unit

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